

Remarks:

Claims 51-70 are pending. Applicant has amended the claims to distinctively claim the subject matter of the invention. By virtue of this amendment, claims 51-53, 57, 60, 62, and 63 are amended. Claims 54, 55, and 64-70 are canceled, and new claim 71 is added. No new matter has been added as support for the amendments is found within the specification and the drawings. It is submitted that the application, as amended, is in condition for allowance.

Interview Summary:

A telephonic Examiner Interview was held with Examiner Wang on February 18, 2009, during which the proposed amendments were discussed in extensive detail. The Examiner insisted that the proposed amendments were unsupported by the Specification as provided in further detail below in the 112 Rejection discussion. The interview was expanded to cover the scope of the Specification as filed including the Figures. The Examiner suggested that the amendments to the claims and the figures were new matter.

The Examiner was provided with references to the portions of the Specification that implicitly or explicitly taught the claimed subject matter within the context of the disclosed idea for proportionally reducing the size of an image after rotating it, in a limited-display device. The Examiner essentially argued, however, that because the figures showed one implementation that was recited in the original claims (e.g., where the image is a perfect square), any claim amendments that are now introduced to recite a different embodiment (e.g., where the image is rectangular) constitute introduction of new matter.

The Examiner was presented several more times with additional arguments and references to the Specification in support of Applicant's position that the rejections under 112 are improper and should be withdrawn. The Examiner indicated that if he could find better references he would withdraw the 112 rejection and rely on 103 grounds of rejection. The Applicant's attorney offered to provide case law references in support of the Applicant's position on why 112 grounds of rejection should be withdrawn. The

Examiner agreed to review the case law and take it into consideration when examining this response.

§112 Rejection(s):

Claims 51-70 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. This rejection is respectfully traversed.

In particular, the claims were rejected for reciting language related to “non-overlapping” and “same aspect ratio.” Figure 3B has been amended to overcome the rejection with respect to the “non-overlapping” language. Corrected drawings, including a replacement sheet for figures 3A and 3B, are provided. Claims 51-53, 57, and 60 have been amended to overcome the rejection with respect to the “same aspect ratio” language.

The Specification discloses a display screen with width A and height B and an image with height C and width D. The image has height C and width D. Please note that these dimensions are different from the dimension of the display screen as shown in Figure 3B as originally filed. Support for the amended Figure 3B is provided in paragraph [0012], lines 3 and 4; paragraph [0027], lines 9 and 10 of the application as file.

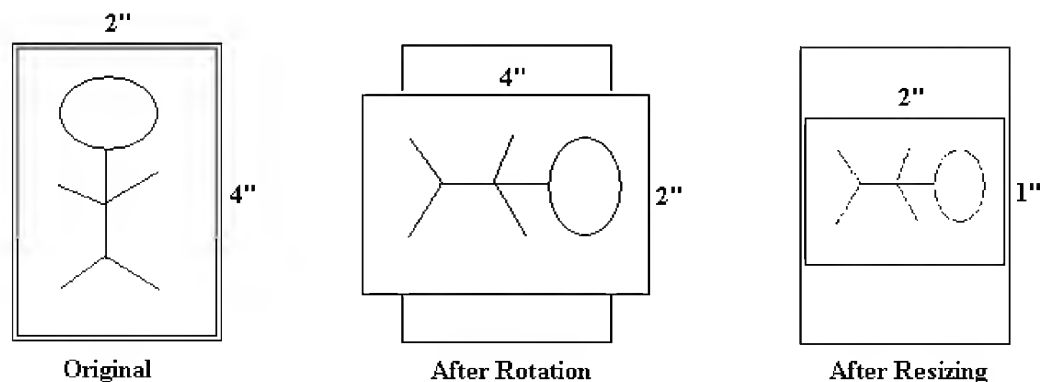
To clarify, please also note that if the rotated version of the image fits in the display screen (i.e., $C = A$ and $D = B$), the image is not resized. If, on the other hand, the rotated version of the image does not fit on the display screen, the rotated image is resized so that $C = A$ and $D = A^2/B$. See paragraphs [0013] and [0029].

In figures 3B and 3D, the image does not occupy the entire display screen due to resizing, and two soft keys are provided in the display screens empty space (i.e., as claimed, a display area represented by an area formed between at least one edge of the display screen and one edge of the image) in response to rotating and resizing the image. See also paragraph [0029]. Figures 3A through 3D, in combination with paragraph

[0029], provide that soft keys are displayed on the display screen is an area of the display screen that does not overlap with the image (i.e., the second display area, as claimed).

On page 27 of the Office Action, the Examiner contends that having at least one of a width and a height of an image adjusted in size means that the aspect ratio is changed. Applicant respectfully disagrees. Regarding claims 52 and 57, adjusting the size of an image does not necessarily change the aspect ratio of the image. The height and width are defined based on the image, however, the Examiner seems to confuse the height and width by defining them based on the display unit dimensions.

For example, in the illustration provided below an image is originally displayed with dimensions approximately the same as a display screen such that $A = D = 2$ inches and $B = C = 4$ inches. The height of the image is twice the width. That is, the ratio of the height (4 inches) to the width (2 inches) of the image is 2:1. After the image is rotated 90 degrees, the image is resized to fit on the display screen such that $A = C = 2$ inches and $D = 1$ inch. The height of the image is still twice the width of the image. That is, the ratio of the height (2 inches) to the width (1 inch) of the image is still 2:1. Thus, the resizing adjusts the width and height of the image, but the aspect ratio remains the same.



The illustration and the definition of “aspect ratio” as disclosed above would be commonly understandable by one of ordinary skill based upon the consideration of all the teachings disclosed in the application as filed. Support for the claims can be provided “in a variety of ways” and “using such descriptive means as words, structures, figures,

diagrams, and formulas” to “show that the applicant was in possession of the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). See, e.g., *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 68, 119 S.Ct. 304, 312, 48 USPQ2d 1641, 1647 (1998).

Further, claim limitations may be supported in the specification through “express, implicit, or inherent disclosure.” See *In re Oda*, 443 F.2d 1200, 170 USPQ 268 (CCPA 1971). Contrary to the Examiner’s understanding, section §112, first paragraph does not require a word-for-word matching between the language in the Specification and the language recited in the claims. If one were to interpret §112, first paragraph, according to the Examiner’s understanding, then the claim language would have to be limited to identical language used in the specification and nothing more.

Referring to MPEP 2163 (II) (A), “[t]he examiner has the **initial burden**, after a thorough reading and evaluation of the content of the application, of presenting evidence or reasons why a person skilled in the art would not recognize that the written description of the invention provides support for the claims. There is a strong presumption that an adequate written description of the claimed invention is present in the specification as filed, *Wertheim*, 541 F.2d at 262, 191 USPQ at 96.” (Emphasis Added).

Therefore, the Examiner is requested to either withdraw the 112 grounds of rejection or provide sufficient evidence or reason why a person skilled in the art would not be able to recognize that the Specification and the Drawings as filed would provide support for the claims, as amended. Particularly, referring to FIG. 3B, it is noted that a the image is revised to show an embodiment in which the image is rectangular (i.e., it’s no a perfect square) such that when the image is rotated an empty space is formed between the image and the lower side of the display, with the icons being displayed in the empty area.

In other words, the icons in FIG. 3B are displayed in an area that is not overlapping with the rotated and reduced in size image. The Examiner contends,

however, that there is no support in the Specification for overlapping, because there is no word-for-word match for the terms “overlapping” or “non-overlapping” in the Specification. As discussed earlier, a word-for-word support for the claim language is not necessary in the Specification in order for the Specification to meet 112 requirements.

The Examiner is again referred to FIGS. 3A and 3B which illustrate that once image rotation is performed, an image height is reduced in accordance with a display width, and an image width is also reduced to prevent image distortion and to maintain the proper aspect ratio. As explicitly disclosed in paragraphs 24 through 26 of the specification, an empty space is formed due to the reduced size of the image and the icons are displayed in the empty space (i.e., non-overlapping with the image.)

For the above reasons, Applicant respectfully submits that the Specification fully supports the claims, when considered in light of the drawings and within the context of the explicit teachings toward a method for reducing the size of an image in conformity with aspect ratio requirements discussed in the Specification. The §112 rejection should be withdrawn.

§103 Rejection(s):

Claims 51-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,154,214 to Uychara et al. (hereafter “Uychara”) in view of U.S. Patent No. 5,661,632 to Register (hereafter “Register”) and U.S. Patent No. 6,747,680 to Igarashi et al. (hereafter “Igarashi”).

Uychara fails to teach or suggest at least one of the elements recited in the claims. In particular, Uychara fails to teach or suggest (1) displaying at least first and second icons in a second display area of the display screen, (a) wherein the first and second display areas are non-overlapping, (b) wherein the first and second icons are associated with functions for rotating the image in first and second directions, respectively, and (c) wherein the second display area comprises a display area represented by an area formed between at least one edge of the display screen and one edge of the image, in response to

rotating and resizing the image. Please note that all of the limitations (a), (b), and (c) must be taught or suggested by a cited reference in order for the cited reference to teach or suggest element (1).

Respectfully, §103 does not allow the Examiner to engage in a picking and choosing from the prior art only to the extent that it will support a holding of obviousness, while excluding parts of the prior art essential to the full appreciation of what the prior art suggests to one of ordinary skill in the art. *In re Wesslau*, 147 USPQ 391 (CCPA 1975).

On the middle of page 33 of the Office Action, the Examiner contends that the rotation icon being non-overlapping with the image having the text area, as disclosed in Uyehara, reads over the first icon being non-overlapping with the image, as recited in claim 51. Applicant respectfully disagrees. The rotation icon disclosed in Uyehara is not equivalent to the first icon recited in claim 51. That is, the rotation icon disclosed in Uyehara is for displaying orientation markers, and is not associated with controlling image display, as recited in claim 51.

The only icons disclosed in Uyehara that are configured to rotate the image in a first direction are the orientation markers, which are overlapped with the image having the text area, as admitted by the Examiner in the same portion of the Office Action. See also column 12, lines 5-6. Accordingly, Uyehara directly teaches away from the first icon being non-overlapping with the image, as recited in claim 51. For this reason alone, Uyehara should be withdrawn for being an improper reference.

Uyehara also fails to teach or suggest (2) rotating the image in a first direction, wherein the first directional key flickers to indicate a change in the image's orientation; and (3) resizing the rotated image so that C is approximately equal to A and D is approximately equal to square of A divided by B, in response to determining that the rotated image does not fit entirely on the display screen, as recited in claim 71. Applicant

has reviewed Uyehara, but cannot find any portion of Uyehara that teaches or suggests elements (2) and (3).

Particularly, in Uyehara the displayed text characters are re-arranged due to the rotation function and the text-wrapping feature. In other words, the text disclosed in Uyehara is not an image within the context claimed and is not rotated and resized in the manner an image is rotated and resized. Therefore, the rotation of the text as suggested in Uyehara will result in a different image being displayed on the screen after the rotation.

In addition, since Uyehara teaches away from claim 51, it would be unreasonable to suggest that a person of ordinary skill in the art would be motivated to combine Uyehara with any other reference. Even assuming, *arguendo*, that Uyehara could be combined with other references, the cited references Register and Igarashi fail to cure the deficiencies of Uyehara.

In particular, Register fails to teach or suggest a second display area that comprises a display area represented by an area formed between at least one edge of the display screen and one edge of the image, in response to rotating and resizing the image, as recited in claim 51.

Igarashi fails to teach or suggest (1) displaying at least first and second icons in a second display area of the display screen, (a) wherein the first and second display areas are non-overlapping, (b) wherein the first and second icons are associated with functions for controlling image display, and (c) wherein the second display area comprises a display area represented by an area formed between at least one edge of the display screen and one edge of the image, in response to rotating and resizing the image, as recited in claim 51.

In fact, the resizing and any soft keys disclosed in Igarashi are associated with a zooming function and speed of navigation, while the rotating and the first and second icons recited in claim 51 are associated with a rotating function and direction of rotation.

Accordingly, Igarashi, like Uyehara, should also be withdrawn for being an improper reference.

With respect to claim 71, Register and Igarashi fail to cure the deficiencies of Uyehara as they fail teach or suggest (2) rotating the image in a first direction, wherein the first directional key flickers to indicate a change in the image's orientation; and (3) resizing the rotated image so that C is approximately equal to A and D is approximately equal to square of A divided by B, in response to determining that the rotated image does not fit entirely on the display screen. Applicant has reviewed Register and Igarashi, but cannot find any portion of Register or Igarashi that teaches or suggests elements (2) and (3).

For the above reasons, neither of the references either alone or in combination teach or suggest the claimed subject matter. Further, while the suggestion to modify or combine references may come from the knowledge and common sense of a person of ordinary skill in the art, the fact that such knowledge may have been within the province of the ordinary artisan does not in and of itself make it so, absent clear and convincing evidence of such knowledge. *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ 2d 1225, 1232 (Fed. Cir. 1998).

Here, the modification or combination proposed by the Examiner is not based on any clear and convincing evidence of a reason, suggestion, or motivation in the prior art that would have led one of ordinary skill in the art to combine the references. Rather, the reason, suggestion and motivation for the combination of references proposed by the Examiner simply is impermissible hindsight reconstruction given the benefit of Applicant's disclosure.

The Federal Circuit has consistently held that hindsight reconstruction does not constitute a prima facie case of obviousness under 35 U.S.C. §103. *In re Geiger*, 2 USPQ 2d 1276 (Fed Cir. 1987). Unfortunately, the Examiner rather than pointing to what the prior art discloses and teaches as to making the suggested modification relies on

assumptions and statements without any support in the record. As such, the Examiner's statements regarding obviousness and motivation to modify are but shortcuts to a conclusion of obviousness devoid of the required analytical approach based on what is actually disclosed in the prior art.

Reliance on impermissible hindsight to avoid express limitations in the claims and setting forth unsupported hypothetical teachings to recreate the Applicant's claimed invention cannot establish a prima facie case of obviousness. Since obviousness may not be established by hindsight reconstruction, Applicant invites the Examiner to point out the alleged motivation to combine with specificity,¹ or alternatively provide a reference or affidavit in support thereof, pursuant to MPEP §2144.03.²

Since no reasonable justification is provided in the Office Action as to how such modification or combination is possible and obviousness may not be established based on hindsight and conjecture, it is respectfully requested that the §103 rejection be withdrawn.

For the above reasons, none of the cited references, either alone or in combination, teach or suggest all the elements recited in claims 51 and 71. Therefore, it is respectfully submitted that claims 51 and 71 in condition for allowance. Claims 52, 53, and 56 depend on claim 51 and should be in condition for allowance by virtue of their dependence on an allowable base claim. Claim 57 is substantially similar to claim 51; therefore, claim 57 and claims 58-63 depending from claim 57 should also be in condition for allowance.

¹ *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

² "The rationale supporting an obviousness rejection may be based on common knowledge in the art or "well-known" prior art . . . If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position. When a rejection is based on facts within the personal knowledge of the examiner . . . the facts must be supported, when called for by the applicant, by an affidavit from the examiner."

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has expressly argued herein that such amendment was made to distinguish over a particular reference or combination of references.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California, telephone number (213) 623 2221 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

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